

Application No. 10/680,464
Response to OA of 07/08/2005

Remarks

In the present response, claims 8, 13-17, 19-20, 35, and 37-42 are canceled. Claims 1-7, 9-12, 18, 21-34, and 36 are presented for examination.

I. Claim Objections

Claim 5 is objected to as being an improper claim for failing to further limit the claim from which it depends. Applicants respectfully traverse.

Applicants argue that the Examiner did not correctly recite the limitations of claim 5. Claim 5 recites "wherein the second region cross-sectional area is substantially similar to the second cross-sectional area" (emphasis added). Notice that the term "second region cross-sectional area" is different than the term "second cross-sectional area."

Applicants respectfully ask the Examiner to withdraw this rejection.

II. Claim Rejections: 35 USC § 102

Claims 1-3 are rejected under 35 USC § 102(b) as being anticipated by USPN 6,349,054 (Hidaka). This rejection is traversed.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Hidaka neither teaches nor suggests each element in claims 1-3, these claims are allowable over Hidaka.

Independent claim 1 recites numerous limitations that are not taught or suggested in Hidaka. For example, claim 1 recites "wherein the first and second lines are T-shaped." Nowhere does Hidaka teach or suggest a magnet memory having first and second lines that are T-shaped.

For at least these reasons, claim 1 is allowable over Hidaka. The dependent claims are allowable for at least the reasons given in connection with claim 1.

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III. Claim Rejections: 35 USC § 102

Claims 9-12, 18-19, 25-33, and 35-36 are rejected under 35 USC § 102(b) as being anticipated by USPN 6,211,090 (Durlam). This rejection is traversed.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See MPEP § 2131, also, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Since Durlam neither teaches nor suggests each element in claims 9-12, 18-19, 25-33, and 35-36, these claims are allowable over Durlam.

Claim 9

Independent claim 9 recites numerous recitations that are not taught or suggested in Durlam. For example, claim 9 recites a magnetic memory having first and second memory lines. The first line has a first region with a first width and a second region with a second width. The second line has a third region sized with the first width and a fourth region sized with the second width.

In contrast to claim 9, FIG. 9 of Durlam teaches a first line 46 and a second line 27. The second line, however, does not have a third region sized with the first width and a fourth region sized with the second width.

For at least these reasons, claim 9 is allowable over Durlam. The dependent claims are allowable for at least the reasons given in connection with claim 9.

Claim 18

Independent claim 18 recites numerous recitations that are not taught or suggested in Durlam. For example, claim 18 recites a magnetic memory cell having first and second lines. The first line has a first width and a second width, the first width being greater than the second width. The second line has a third width and a fourth width, the third width being greater than the fourth width.

In contrast to claim 18, FIG. 9 of Durlam teaches a first line 46 and a second line 27. The second line, however, does not have a third width and a fourth width, the third width being greater than the fourth width.

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For at least these reasons, claim 18 is allowable over Durlam. The dependent claims are allowable for at least the reasons given in connection with claim 18.

Claim 29

Independent claim 29 recites numerous recitations that are not taught or suggested in Durlam. For example, claim 29 recites a magnetic memory device having first and second lines. The first and second lines have a T-shaped face.

In contrast to claim 29, FIG. 9 of Durlam teaches a first line 46 and a second line 27. Both the first and second lines, however, do not have a T-shaped face.

For at least these reasons, claim 29 is allowable over Durlam. The dependent claims are allowable for at least the reasons given in connection with claim 29.

IV. Claim Rejections: 35 USC § 103

Claims 4-8, 20-24, 34, and 37 are rejected under 35 USC § 103(a) as being unpatentable over Durlam. Applicants respectfully traverse.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

As discussed above in Section III, Durlam does not teach or suggest all the limitations of independent claims 9, 18, and 29. Thus, for at least the reasons given in connection with independent claim 9, 18, and 29, the dependent claims 4-8, 20-24, 34, and 37 are also allowable over Durlam. Withdraw of this rejection is respectfully requested.

Response to Office Action Arguments

The Office Action admits that Durlam does not disclose all the recitations of the dependent claims ("Durlam discloses all the inventions except for the duplication of the

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essential working parts of the device") Applicants agree with this admission. The Office Action, however, attempts to cure these deficiencies by stating "these features are considered routine skill for one of ordinary skill in the art." Applicants respectfully disagree.

First, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999). No such objective evidence is being provided. Instead, the Office Action makes an unsupported conclusion that the claimed features are routine skill for one of ordinary skill in the art. Applicants respectfully ask the Examiner to cite a location in Durlam for supporting this argument.

Second, Applicants argue that the Office Action is using hindsight construction to reject the claims. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Unirayal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Durlam does not teach or suggest a reason or motivation for altering its embodiments. In other words, nothing in Durlam itself suggests the desirability of altering its invention to arrive at elements of Applicants' claims.

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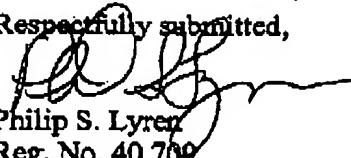
CONCLUSION

In view of the above, Applicants believe all pending claims are in condition for allowance. Allowance of these claims is respectfully requested.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

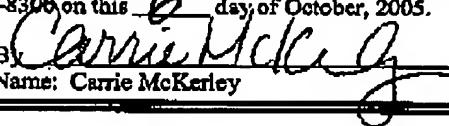
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Respectfully submitted,


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CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 6 day of October, 2005.


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